UNITED STATES PATENT AND TRADEMARK OFFICE

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10/081,255	02/22/2002	Leslie Beth Herbert	83647RLO	9959

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EXAMINER
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ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/081,255	HERBERT, LESLIE BETH
	Examiner	Art Unit	
	Athanasios Tom Papanikolaou	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date 6/24/03 + 2/22/02

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The references listed in the Information Disclosure Statement submitted on

6/26/03 have been considered by the examiner (see attached PTO-1449).

The information disclosure statement filed 2/22/02 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because only the cover pages are

submitted for non-patent literature. It has been placed in the application file, but the

information referred to therein has not been considered as to the merits. Applicant is

advised that the date of any re-submission of any item of information contained in this

information disclosure statement or the submission of any missing element(s) will be the

date of submission for purposes of determining compliance with the requirements based

on the time of filing the statement, including all certification requirements for statements

under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-3, 7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated

by Robinson et al. (U.S. Patent Application Publication 2002/0065844 A1).

Regarding claim 1, Robinson discloses **a method of using stored digital**

images transferred from an imaging device, comprising the steps of: receiving

and storing images from the imaging device in a memory associated with a

computer (paragraph 32 and claim 1(a & b)); **receiving at least one control file from**

the imaging device which indicates a prior intention for subsequent use of the

stored images (paragraph 32 and claim 1(c)), **the computer responding to the**

control file to create and display a list of tasks selectable by a computer user in

accordance with the prior intention (paragraphs 30 and 33); **the computer user**

selecting at least one of the tasks from the list (claim 5); **and the computer**

responding to the user selected tasks to initiate the use of images indicated by

the selected tasks (claim 6).

Regarding claim 2, Robinson discloses the limitations of claim 1 as stated above

and further discloses **wherein the transferred digital images include corresponding**

thumbnail images (see Fig. 2 and paragraph 17).

Regarding claim 3, Robinson discloses the limitations of claim 2 as stated above

and further discloses **wherein the displayed list of tasks includes thumbnail images**

of corresponding digital images (paragraph 30, the data file may provide a collection

of image data, which include thumbnails as stated in paragraph 17, and provide a menu

selection for the user).

Regarding claim 7, Robinson discloses **a method of using stored digital**

images transferred from a digital camera (see Fig. 1 and paragraph 14), **comprising**

the steps of: receiving and storing digital images and corresponding thumbnail

images (see Fig. 2) **from the digital camera in a memory associated with a**

computer (paragraph 32 and claim 1(a & b)), **receiving a control file from the digital**

camera which indicates a prior intention (paragraph 32 and claim 1(c)) **for**

subsequently making prints of the digital images or sending such images to a

remote location (claim 16) **the computer responding to the control file to create a**

list of tasks selectable by the computer user in accordance with the prior

intention (paragraphs 33), **displaying the list of selectable tasks and the thumbnail**

images (paragraph 30, the data file may provide a collection of image data, which

includes thumbnails as stated in paragraph 17, and provide a menu selection for the

user) **associated with the images to be used for the selected tasks** (paragraphs 30

and 33) **and a computer user selecting a task** (claim 5) **and the computer**

responding to the user selected tasks to initiate the use of images indicated by

the selected tasks (claim 6).

Regarding claim 11, Robinson discloses **a method of using stored images**

captured by a digital camera, comprising the steps of: using the digital camera to

capture digital images and store such captured digital images in a digital memory

(paragraph 14) a user selecting particular digital images and indicating a plurality

of intentions to use such captured digital images (paragraph 30, lines 1 through 12),

the camera producing a plurality of control files in accordance with the user

indicated plurality of intentions(paragraph 32 and claim 1(c)), the control files

including identifiers corresponding to the user selected particular digital images

(see Fig. 2 and Fig. 3), and storing such control files in the digital memory, the

computer receiving the control files from the digital camera (paragraph 32 and

claim 1(a & b)), the computer responding to the control files to create a list of

tasks selectable by the computer user in accordance with the plurality of

intentions(paragraph 33), the computer displaying the list of selectable

tasks(paragraph 30), and the computer user selecting one of the tasks (claim 5),

and the computer responding to the user selected task to initiate the use of

images indicated by the selected task (claim 6).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 4-6, 8-10,12, and 14 are rejected under 35 U.S.C. 103 (a) as being

unpatentable over Robinson in view of Kimbell et al. (U.S. Patent Application

Publication 2003/0014416 A1).

Regarding claim 4, Robinson discloses **the method of claim 3** as stated above.

Robinson does not disclose expressly **wherein there are multiple control files**

one of which includes the desired number of copies to be printed and which is

included in a first task, and another control file which includes at least one email

address where digital images are to be sent and is included in a second task, and

wherein the user selects either the first or second task to be initiated by the

computer.

Kimbell discloses the limitations of claim 3 as stated above and further discloses

wherein there are multiple control files (paragraph 31, multiple objects are supplied

for a structure of desired operations; paragraph 32, an intent file includes a profile and

intent file and, as stated in paragraph 33, transferred to the destination), **one of which**

includes the desired number of copies to be printed and which is included in a

first task (paragraph 45), **and another control file which includes at least one email**

address where digital images are to be sent and is included in a second task (see

Fig. 5 and paragraphs 33 and 34), **and wherein the user selects either the first or**

second task to be initiated by the computer (paragraph 26).

Robinson and Kimbell are combinable because they are from the same field of

endeavor namely image processing. At the time of the invention it would have been

obvious to a person of ordinary skill in the art to have Robinson's method include a

control file designating the number of copies to print and an email address to send the images along with a user selecting either task, as taught by Kimbell. The suggestion or motivation for doing so would have been that Robinson's system could provide a user with the flexibility to choose between emailing and printing an image. Therefore, it would have been obvious to combine the teachings of Kimbell with the method of Robinson to obtain the invention in claim 4.

Regarding claim 5, Robinson discloses **the method of claim 1** as stated above.

Robinson does not disclose expressly discloses **including the step of the user modifying the task prior to step (e).**

Kimbell discloses **including the step of the user modifying the task prior to step (e)** (paragraph 31, the module can be used to manipulate the objects).

Robinson and Kimbell are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Robinson's method include a means of modifying the image transfer method, as taught by Kimbell. The suggestion or motivation for doing so would have been that Robinson's system could provide a user with the flexibility to modify the distribution characteristics of the system. Therefore, it would have been obvious to combine the teachings of Kimbell with the method of Robinson to obtain the invention in claim 5.

Regarding claim 6, Robinson and Kimbell disclose **the method of claim 4** as

stated above.

Kimbell further discloses **including the step of the user modifying the task**

prior to step (e) (paragraph 31, the module can be used to manipulate the objects).

Regarding claim 8, Robinson discloses **the method of claim 7** as stated above.

Robinson does not disclose expressly **wherein there are multiple control files,**

one of which includes the desired number of copies to be printed using one of

the digital images and which is included in a first task, and another of which

includes a remote location where digital images are to be sent and which is

included in a second task, and wherein the user selects either the first or second

task to be initiated by the computer.

Kimbell discloses **wherein there are multiple control files** (paragraph 31,

multiple objects are supplied for a structure of desired operations; paragraph 32, an

intent file includes a profile and intent file and, as stated in paragraph 33, transferred to

the destination), **one of which includes the desired number of copies to be printed**

using one of the digital images and which is included in a first task (paragraph 45),

and another of which includes a remote location (paragraph 43) **where digital**

images are to be sent and which is included in a second task (see Fig. 5 and

paragraphs 33 and 34), **and wherein the user selects either the first or second task**

to be initiated by the computer (paragraph 26).

Robinson and Kimbell are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Robinson's method include a control file designating the number of copies to print and a link to a remote destination to send the images along with a user selecting either task, as taught by Kimbell. The suggestion or motivation for doing so would have been that Robinson's system could provide a user with the flexibility to choose between sending an image to a remote destination or printing the image immediately. Therefore, it would have been obvious to combine the teachings of Kimbell with the method of Robinson to obtain the invention in claim 8.

Regarding claim 9, Robinson discloses **the method of claim 7** as stated above.

Robinson does not disclose expressly discloses **including the step of the user modifying the task prior to step (e).**

Kimbell discloses **including the step of the user modifying the task prior to step (e)** (paragraph 31, the module can be used to manipulate the objects).

Robinson and Kimbell are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Robinson's method include a means of modifying the image transfer method, as taught by Kimbell. The suggestion or motivation for doing so would have been that Robinson's system could provide a user with the flexibility to modify the distribution characteristics of the system. Therefore, it

would have been obvious to combine the teachings of Kimbell with the method of Robinson to obtain the invention in claim 9.

Regarding claim 10, Robinson and Kimbell disclose **the method of claim 8** as stated above.

Kimbell further discloses **including the step of the user modifying the task prior to step (e)** (paragraph 31, the module can be used to manipulate the objects).

Regarding claim 12, Robinson discloses **the method of claim 11** as stated above.

Robinson does not disclose expressly **wherein the control file, which includes the desired number of copies of digital images to be printed and which is included in a first task and a second control file which includes an email address where digital images are to be sent and is included in a second task, and the user selecting either the first or second task to be initiated by the computer.**

Kimbell discloses **wherein the control file** (paragraph 31, multiple objects are supplied for a structure of desired operations; paragraph 32, an intent file includes a profile and intent file and, as stated in paragraph 33, transferred to the destination), **which includes the desired number of copies of digital images to be printed and which is included in a first task** (paragraph 45), **and a second control file which includes an email address where digital images are to be sent and is included in a**

second task (see Fig. 5 and paragraphs 33 and 34), **and the user selecting either**

the first or second task to be initiated by the computer (paragraph 26).

Robinson and Kimbell are combinable because they are from the same field of

endeavor namely image processing. At the time of the invention it would have been

obvious to a person of ordinary skill in the art to have Robinson's method include a

control file designating the number of copies to print and an email address to send the

images along with a user selecting either task, as taught by Kimbell. The suggestion or

motivation for doing so would have been that Robinson's system could provide a user

with the flexibility to choose between emailing and printing an image. Therefore, it would

have been obvious to combine the teachings of Kimbell with the method of Robinson to

obtain the invention in claim 12.

Regarding claim 14, Robinson and Kimbell disclose **the method of claim 12** as

stated above.

Kimbell further discloses **including the step of the user modifying the task**

prior to step (g) (paragraph 31, the module can be used to manipulate the objects).

6.   Claim 13 and 15 are rejected under 35 U.S.C. 103 (a) as being unpatentable

over Robinson in view of Fujimura (U.S. Patent Application Publication 2002/0067923

A1).

Regarding claim 13, Robinson discloses **the method of claim 11** as stated

above.

Robinson does not disclose expressly discloses **wherein the plurality of control files are provided by the camera capturing a first set of digital images and producing a first control file, the computer receiving the first control file and the first set of digital images from the digital camera and, the computer then causing the first control file and the first set of digital images to be erased from the digital camera, the digital camera subsequently capturing a second set of digital images and producing a second control file, and the computer receiving the second control file and the second set of digital images, prior to step (f).**

Fujimura discloses **wherein the plurality of control files are provided by the camera capturing a first set of digital images and producing a first control file, the computer receiving the first control file and the first set of digital images from the digital camera and, the computer then causing the first control file and the first set of digital images to be erased from the digital camera** (see Fig. 5 and paragraph 70), **the digital camera subsequently capturing a second set of digital images and producing a second control file, and the computer receiving the second control file and the second set of digital images, prior to step (f)** (see Fig. 8, the deletion process is repeatable).

Robinson and Fujimura are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Robinson's method include a means of deleting the image data from the camera after they are received by the computer, as taught by Fujimura. The suggestion or motivation for doing so would have

been that Robinson's system could increase the storage capacity of the digital camera.

Therefore, it would have been obvious to combine the teachings of Fujimura with the

method of Robinson to obtain the invention in claim 13.

Regarding claim 15, Robinson discloses **a method of capturing and using**

stored images captured by a digital camera, comprising the steps of: using a

digital camera to capture digital images and store such captured digital images in

a digital memory (paragraph 14); **the user selecting particular digital images and**

indicating an intention to use such captured digital images(paragraph 30, lines 1

through 12); **the camera producing a control file in accordance with the user**

indicated intention(paragraph 32 and claim 1(c)), **and including identifiers**

corresponding to the user selected particular digital images(see Fig. 2 and Fig. 3),,

and storing such control tile in the digital memory ; the computer receiving the

control file from the digital camera(paragraph 32 and claim 1(a & b)); **the computer**

responding to the control file to create a list including at least one task selectable

by the computer user in accordance with the user indicated intention(paragraph

33); **subsequent to step (f), the computer displaying the list of selectable**

tasks(paragraph 30) **and the computer user selecting one of the tasks**(claim 5); **and**

the computer responding to the user selected task to initiate the use of images

indicated by the selected task(claim 6).

Robinson does not expressly disclose **the computer initiating deletion of the**

control file and the digital images from the digital memory of the digital camera

Fujimura discloses **the computer initiating deletion of the control file and the digital images from the digital memory of the digital camera** (see Fig. 5 and paragraph 70).

Robinson and Fujimura are combinable because they are from the same field of endeavor namely image processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to have Robinson's method include a means of deleting the image data from the camera after they are received by the computer, as taught by Fujimura. The suggestion or motivation for doing so would have been that Robinson's system could increase the storage capacity of the digital camera. Therefore, it would have been obvious to combine the teachings of Fujimura with the method of Robinson to obtain the invention in claim 15.

7.   Claim 16 recites identical features as claim 1 except claim 16 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 16 because without a computer readable medium to store a program that makes it possible for the system to operate, the system taught by Robinson, the rejections for claim 16 could not function.

Citation of Pertinent Prior Art

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Stoecker (U.S. Patent Application Publication 2002/0010722 A1) discloses a system which acquires an image, automatically makes selections based on information within a transferred image data file, provides a custom dialog box to a user, and subsequently prints the image.

Kawamura et al. (U.S. Patent 6,522,354) discloses an electronic camera that displays image frames, to permit the selection of items of information to be transferred to external equipment.

Yoshida (U.S. Patent Application Publication 2002/0010722 A1) discloses transmitting data, including image data, to a destination. A user menu is provided with emailing and printing capabilities.

Takayama (U.S. Patent Application Publication 2002/0010722 A1) discloses an image processing apparatus obtaining and printing plural pieces of image data from a storage medium.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Athanasios Tom Papanikolaou whose telephone number is (571)272-7953. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A.P.

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PRIMARY EXAMINER
ART UNIT 2622